

REMARKS

The most recent Office Action withdrew the previous rejection, but submitted new grounds of rejection.

The Office Action rejected claims 54, 56-65 and 67-71 under 35 U.S.C. Section 103 (a) as being unpatentable over Fritzschn 5,441,499 in view of Bays 5,796,188. The Office Action also rejected claim 66 under 35 U.S.C. Section 103 (a) as being unpatentable over Fritzschn 5,441,499 in view of Bays 5,796,188 and Swanson et al. 6,123,702.

Fritzschn discloses a bipolar radio-frequency surgical instrument for cutting tissue. The surgical device is designed for laparoscopic surgery. Fritzschn states this means that it must be insertable through a trocar to the site of the operation without any problems. Typical laparoscopic surgeries include at least two body access points. One access point typically includes a viewing system with a light and one access point typically includes a surgical device for affecting tissue. All other things being equal, it is preferred to keep the size of the incision for an access point as small as possible.

The Office Action proposes that it would be obvious to add the battery and light system of Bays to Fritzschn. Applicants respectfully disagree for several reasons.

The system of Fritzschn is designed for laparoscopic surgical procedures. The addition of a battery and light system would add bulk, weight and complexity to the ablation system of Fritzschn. This is inconsistent with the general desire in laparoscopic procedures to keep the incision length for trocar access to a minimum. One of ordinary skill in the art would not seek to add such a feature to the ablation system of Fritzschn as such a proposed addition would add to the bulk, weight or size of the system.

Fritzschn is a *cutting* ablation system. This is a relatively aggressive form of ablation when compared to other forms of ablation such as an ablation system only designed to kill tissue while preserving its structural integrity. A cutting device removes tissue and creates an environment that is very likely to fog or cloud optical instrumentation. One of ordinary skill in the art would not add a light that would only be quickly clouded or fogged by the cutting function of the device.

On multiple occasions, Fritzsich mentions problems associated with viewing during laparoscopic cutting procedures. These problems would not be solved by adding a light and battery system directly to Fritzsich. Instead, Fritzsich discloses a different solution to the viewing problem. As a result, Fritzsich teaches directly away from the proposed combination advocated by the Office Action.

The Office Action is silent with respect to how claim 71 reads on Fritzsich. Claim 71 calls for a limitation wherein "the rounded tip portion [is] free of any electrode movable relative to the rounded tip portion." Clearly Fritzsich does not disclose this limitation in combination with the remaining claim features and neither Bays nor Swanson cure that deficiency. For this additional reason, claim 71 is allowable over the cited art.

Swanson does not cure the deficiencies of Fritzsich and Bays. As a result, claim 66 is also allowable as well.

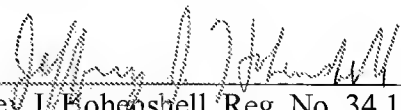
It is respectfully submitted that the pending claims are in condition for allowance.

No fee is believed due for this submission. Please charge any additional fees or credit any overpayment to Deposit Account No. 13-2546.

If the Examiner comes to believe that a telephone conversation may be useful in addressing any remaining open issues in this case, the Examiner is invited to contact the undersigned at 763-505-8426.

Respectfully submitted,

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